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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,836	10/12/2001	Marco Peters	Q66094	7385

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/974,836

**Applicant(s)**

PETERS ET AL.

**Examiner**

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. ***The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.*** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Appropriate correction is required.

### *Claim Objections*

2. Claims 2 and 6 are objected to because of the following informalities:

Claim 2 recites "Terminal according to claim 1, characterized in that said terminal comprises a transmitter ***for in*** response to said overrule signal transmitting an information signal to a network-unit, with said network-unit comprising a sender ***for in*** response to said information signal sending a response signal to said terminal for amending said browsing." Such language is confusing and is not proper idiomatic English. Examiner believes applicant intended for the claim to read, "Terminal according to claim 1, characterized in that said terminal comprises a transmitter signal transmitting an information signal to a network-unit in response to said overrule signal,

with said network-unit comprising a sender for sending a response signal to said terminal for amending said browsing in response to said information signal.”

Claim 6 contains the same language.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 3, 6, 7, and 9 – 10 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 00/46697 (Bending et al.)

As to claims 1, 9, and 10, Bending et al. teaches an apparatus and related method wherein, a mobile telephone unit 100 read as the claimed terminal has a browser function therein for browsing a network such as the Internet. (Fig. 1, P. 9, lines 5 – 19) Bending et al. further teaches a telephony unit 170 read as the claimed processor. (P. 9, line 21 – P. 10, line 1) Note that even if telephony unit 170 does not operate browser 130, it is inherent that some processor in unit 100 operates the browser software. There would be no other way for the browser to function as a browser is merely a software program/module. Bending et al. also teaches memory 150

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with which browser 130 operates. (Fig. 4, P. 14, line 6 – P. 15, line 10) Again, as with the above-mentioned processor, there also must be other memory in unit 100 in order for the unit 100 to function. Any mobile unit has a processor and at least some memory used for operating the unit and any other function/feature to be used on that unit.

Bending et al. further teaches a man-machine-interface in the form of either a keypad 114 on unit 100 or the actual browser graphical user interface 182 for allowing a user of unit 100 to interact with the unit/browser. (Fig. 3, P. 12, line 22 – Col. 14, line 4)

Finally, Bending et al. also teaches that user may override the browser function on unit 100 by invoking automatic call module 140 to disconnect unit 100 from local internet server 222 or to suspend the browsing function. (P. 5, lines 9 – 17, P. 6, lines 16 – 25, P. 10, lines 11 – 24) Note that the automatic call module 140 reads on the claimed generator in that some signaling/messaging inherently must be sent/recognized from the module 140 to instruct unit100/browser 130 to cease/suspend browsing operations.

As to claim 2, Bending et al. teaches various embodiments/ways to implement the override function/automatic call module 140, one of which is to use JAVA applets. JAVA applets allow a browser to download a program or some functionality (via a browser, such as browser 130) at the time it is to be used. Because JAVA applets reside on a server, read as the claimed network-unit, in the Internet network, browser 130 transmits some signal to the website/server requesting the JAVA applet in response to the above-discussed invocation of module 140. In response, the server, sends a response signal to amend browsing, which in this instance is the actual JAVA applet

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sent to unit 100 to allow for browsing to be cancelled/suspended so that a telephony call can be made. (P. 24, line 23 – P. 29, line 8, P. 30, lines 14 - 25)

As to claim 3, Bending et al. teaches that after a telephony connection has been made, automatic call module 140 causes reconnection to internet server 222 and retrieves the last stored website data from memory and connects to that website and displays the associated website information. Such reads on the claimed generation of a previous address signal in that the disconnecting/suspending of browsing reads on the claimed amending aspect.

As to claim 6, see the rejection of claims 1 and 2.

As to claim 7, see the rejection of claim 3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/46697 (Bending et al.)

As to claim 5, Bending et al. has been discussed above. What Bending et al. does not exactly teach is a finish of the browser function.

Bending et al. does teach, as discussed above, actually disconnecting the unit 100, and consequently browser 130 from the local internet server 222. This effectively "finishes" the browser function because it can no longer browse the web. Interpreted in another way however, finishing the browser function can mean actually ending the browser program. Bending et al. does not mention actually closing the browser. Also, in some circumstances, it is old and well known that a browser may be used off-line, accessing stored web pages even though a connection to the internet does not exist.

However, such a feature would merely be a design choice or preference for one of ordinary skill in the art at the time the invention was made. A motivation for actually closing the browser is to save resources and memory and processing power on unit 100. If there is no connection to internet server 222, there is no reason to have browser 130 open on unit 100. It is known in the art that mobile telephones already "suffer" from either lack of processing power or lack of operating memory due to their increasingly small physical dimensions and closing the browser would save that processing power and memory.

As to claims 4 and 8, Bending et al. has been discussed above. What Bending et al. does not teach is a reset of the browser function.

Bending et al. teaches the ability to suspend browsing or actually disconnect from local internet server 222 and then reconnect unit 100 and browser 130 thereto. In effect, this is a "reset" of the browsing function since the browsing is first stopped as discussed above with regard to claim 5, and then re-initiated.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,982,774 (Foladare et al.) teaches internet on hold wherein a user connected to the internet over telephone can instruct the override of the browsing function which is effected by messaging between the user's terminal and the internet access provider or network-unit. US 6,028,915 (McNevin) teaches a method and apparatus for making an emergency call while on-line on a computer. US 6,208,718 (Rosenthal) teaches an emergency interrupt technique for a user on-line.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.  
May 26, 2004

HECTOR A. AGDEPPA  
PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Hector A. Agdeppa', is written over the printed name and title.